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10/688,006	10/17/2003	Russell T. White JR.	END920030046US1	4391

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EXAMINER
LEVINE, ADAM L

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2009*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendments and remarks filed June 19, 2009, are responsive to the office action mailed March 19, 2009. Independent claims 1, 8, 14, and 19 have been amended and dependent claims 2 and 9 have been amended. Claims 1-22 are currently pending and considered in this office action.

Response to Amendment

Pertaining to rejection under 35 USC 112, first paragraph, in the prior office action

Claims 1-22 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The "specified attribute" claimed in the amendments to claims 1, 8, 14, and 19, is not described in the specification and was not claimed or otherwise disclosed in the original specification. Applicant's amendments filed June 19, 2009, have been fully considered. The amendments have removed the offending element and the rejection is thereby overcome.

Pertaining to rejection under 35 USC 112, second paragraph, in the prior office action

Claims 1, 8, 14, and 19 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's amendments filed June 19, 2009, have been fully considered and this rejection has been overcome.

Pertaining to rejection under 35 USC 101 in the previous office action

Claims 1-18 were rejected under 35 USC 101. Applicant's amendments filed
June 19, 2009, have been fully considered and the rejection of claims 1-7, 9, and 13
under 35 USC 101 is withdrawn. The rejection is maintained with regard to claims 8,
10-12, and 14-18.

Response to Arguments

Pertaining to rejection under 35 USC 101 in the previous office action

Applicant's arguments filed June 19, 2009, have been fully considered but they
are not persuasive. Applicant argues that claim 8 has been amended similarly to claim
1 however the amendments are not the same. The tie to a machine or apparatus in
claim 8 is insufficient because it is directed to mere data gathering, input or output
functions. Applicant's attention is directed to the second paragraph of claim 8,
"identifying, on the at least one computer..." Because the act of "identifying" is
performed by the user, the step is not tied to the machine or apparatus in any
sufficiently limiting way. Rather, the step is performed by the human user who is merely
in communication with the machine or apparatus (in other words, the computer merely
receives input from the user). Although similar language appears in claim 1, other steps
in claim 1 are sufficiently tied to a machine or apparatus. These steps are not present
in claim 8.

Claims 14-18 provide for the use of various systems or system elements, but the
system components as claimed are lacking structural specificity and are potentially

purely software components. If so, the claims are directed at a computer program not claimed as embodied in a computer-readable medium and as being implemented in a computer apparatus.

Pertaining to rejection under 35 USC §102(b) in the previous office action

Applicant's arguments filed June 19, 2009, have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "an automatically generated dynamic query for each level of a hierarchical structure which returns frequency items with a dynamic page for a user.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the prior art does discloses "a recursive process is preferably used to elevate the nodes within the tree," but does not distinguish this from the present claims. It is examiner's position that a recursive process also describes a process wherein a query for each level of a hierarchy is repeated, recursively. It is additionally noted that the indication of a preferable means to an end does not preclude the presence of other means to the same end.

Regarding the automatic generation of queries, in recalling an item the query is automatically generated for each level of the hierarchical structure. This is performed by both the present invention and the prior art as the query levels of the item are recalled from storage and/or replicated recursively in order to present the new query in

process while bringing the highlighted popular item to the front of a category or

subcategory in which the item appropriately belongs. Spiegel refers to its hierarchical

structure as a browse tree, and to query levels as nodes (which can refer to either

categories or items). Spiegel describes automatically identifying nodes and calling them

to attention by elevating them along child-parent paths. These paths are the

hierarchical query levels described in the present application (see at least column 1

lines 60-66, column 2 lines 25-30, 41-43). This means that the each level of the query

is automatically generated and repeated.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

1.   **Claims 8, 10-12, and 14-18 are rejected under 35 U.S.C. 101 because the**

claimed invention is directed to non-statutory subject matter.

Claims 8 and 10-12 are directed to a method or process. The first step in

determining whether a claim recites patent eligible subject matter is to determine

whether the claim falls within one of the four statutory categories of invention recited in

35 USC 101: process, machine, manufacture and composition of matter. The latter

three categories define "things" or "products," while a "process" consists of a series of

steps or acts to be performed. For purposes of section 101, a "process" has been given

a specialized, limited meaning by the courts. Based on Supreme Court precedent and

recent Federal Circuit decisions, a process must (1) be tied to a particular machine or

apparatus, or (2) transform a particular article to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process. See In re Bilski, 2008 U.S. App. LEXIS 22479. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

In order to qualify as a statutory process, therefore, claims should positively recite the machine or apparatus to which they are tied, for example by identifying the machine or apparatus that accomplishes the method steps, or they should positively recite the particular article that is being transformed, for example by identifying the material that is being changed to a different state. The mere manipulation of data is not transformation of a particular article. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

The tie to a machine or apparatus in claim 8 is insufficient because it is directed to mere data gathering, input or output functions. Applicant's attention is directed to the second paragraph of claim 8, "identifying, on the at least one computer..." Because the act of "identifying" is performed by the user, the step is not tied to the machine or

apparatus in a meaningfully limiting way. Rather, the step is performed by the human

user who is merely in communication with the machine or apparatus (in other words, the

computer merely receives input from the user).

Claims 14-18 provide for the use of various systems or system elements, but the

system components as claimed are lacking structural specificity and are potentially

purely software components. If so, the claims are directed at a computer program not

claimed as embodied in a computer-readable medium and as being implemented in a

computer apparatus. Mere recitation in the preamble (i.e., intended use) or mere

implication of employing a machine or article of manufacture does not confer statutory

subject matter to an otherwise abstract idea.

Computer programs claimed per se, i.e., the descriptions or expressions of the

programs, are not physical "things." They are neither computer components nor

statutory processes, as they are not "acts" being performed. Such claimed computer

programs do not define any structural and functional interrelationships between the

computer program and other claimed elements of a computer that permit the computer

program's functionality to be realized. In contrast, a claimed computer-readable

medium encoded with a computer program is a computer element which defines

structural and functional interrelationships between the computer program and the rest

of the computer which permit the computer program's functionality to be realized, and is

thus statutory. Accordingly, it is important to distinguish claims that define descriptive

material per se from claims that define statutory inventions. MPEP 2106 IV B 1 (a).

Although an examination of the specification indicates that "a storage system" is

intended to refer to a machine or apparatus, it is the only element for which this is the

case. This is insufficient because even if so interpreted it merely refers to a machine or

apparatus storing data and would therefore be nonstatutory because the claims are

neither a properly claimed method meeting the statutory requirements discussed above

nor a properly claimed computer readable medium product containing computer

executable programming code. The remaining systems or system elements are not

rendered statutory by the mere implication that there is a "user device" or "computer

device" somehow involved in the process because as discussed, these are not process

claims, and because the mere presence of a computer does not render improperly

claimed software statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   **Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Spiegel (Paper #051102; US Patent No. 6,466,918).

Spiegel teaches all the limitations of Claims 1-22. For example, with regard to

method claims 1-13, Spiegel discloses a method for storing on at least one computer

device, items in a hierarchical structure, allowing users to select items within that

structure, identifying frequently purchased items, and elevating them for display on a higher level in the structure than that on which they would normally appear (see at least Abstract, Figs. 1A-4, column 1 lines 5-15). Spiegel further discloses:

- storing items in a hierarchical structure: wherein each of the items is located using a database search query for each level of the hierarchical structure, wherein the query returns a set of records containing the items based on a level of the hierarchical structure selected and queried (see at least Abstract, Figs. 1A-8, column 1 lines 25-59, column 5 line 10-column 6 line 5, column 7 lines 5-25); a page is dynamically generated for a user at a user device based on the result of the query (see at least fig.1A, column 2 lines 25-36, column 5 lines 3-10, column 7 lines 5-24, 59- column 8 line 8).

- identifying on the at least one computer device at least one high frequency item: wherein the at least one high frequency item is an item that is frequently purchased (see at least Abstract, Fig. 3, column 1 lines 7-13, column 1 line 60 – column 2 line 36, column 6 lines 5-20); maintaining a record of the frequency that each of the items has been purchased (see at least Abstract, column 2 lines 12-24, column 3 lines 13-29, column 6 lines 5-20, 30-39. Please note: this element is interpreted as referring to the storage of information regarding the frequency of purchase of each item.); a separate record of the frequency of purchase of each of the items is maintained for each of a plurality of groups of users (see at least column 7 line 59-column 8 line 7, column 9 line 64 – column 10 line 16.).

- <u>automatically generating on the at least one computer device the query</u>: for each level of the hierarchical structure to display the at least one high frequency item on a high level page wherein the query is dynamically generated by the at least one computer device at the time of selecting the level of the hierarchical structure and incorporates the selection of the administrator (see at least Abstract, Figs. 1A,2-4,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 7 lines 5-25).

- <u>presenting the item to an administrator for the group of users</u>: selecting at least one high frequency item for display on the high level page for each user in a group of users wherein the administrator determines if the at least one high frequency item is displayed on a high level page and on which high level page the at least one high frequency item is displayed (see at least Abstract, Figs. 1A,2-4,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 4 line 64-column 5, column 6 lines 5-20, column 7 lines 5-25, column 13 lines 40-50, column 15 lines 10-25).

- <u>storing the operations performed by a user to select an item in the hierarchical structure</u>: analyzing the stored operations, obtaining the query for each level based on the stored operations (see at least Abstract, Figs. 1-4,5,7,9,11; column 1 line 60 – column 2 line 4, column 2 lines 26-36, column 6 lines 5-20, column 9 line 64-column 10 line 26.).

- an identification system for identifying a user: (see at least column 2 line 46 –

  column 3 line 12, column 6 line 40 – column 7 line 5, column 11 lines 34-50,

  column 12 line 61 – column 13 line 7).

Pertaining to system claims 14-18

Rejection of system claims 14-18 is based on the same rationale as noted above.

Pertaining to computer program product claims 19-22

Rejection of computer program product claims 19-22 is based on the same

rationale as noted above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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November 3, 2009
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